

FILE COPY**Office Action Summary**

Application No.

08/192,800

Applicant(s)

SUDOH ET AL.

Examiner

Sean R McGarry

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1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7 and 10-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-7, 10-32, 34 and 35 is/are rejected.
- 7) ☒ Claim(s) 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 54. 6) ☐ Other: _____

DETAILED ACTION

This application was suspended 1/30/1997 awaiting a relevant reference. The reference is available and prosecution on the merits is reopened. Applicant arguments set forth in the Brief filed 11/13/95 are moot in view of the new grounds of rejection set forth below. Any rejection of record not repeated below is withdrawn.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 2-7, 10-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Seilhamer et al. [US 5,948,761].

Seilhammer et al disclose the claimed invention in claims 3-7 where it is disclosed a nucleic acid sequence which encodes the polypeptide sequences of claims 1 and 2. It is noted that with the degeneracy of the genetic code the nucleic acid sequences of the instant claims are disclosed by claims 3-7 of Seilhamer et al and further Seilhamer discloses SEQ ID NO:s 44, 45, and 46 which comprise the sequences instantly recited in the claims. It is noted that the product by process claims (24-29) are anticipated since there is nothing in the methodology that would indicate that the process would produce a material difference in the nucleic acids as disclosed by Seilhamer et al. Seilhamer et al disclose the method of using a porcine or other vertebrate "NP" probes to discover other "NP" polypeptides at column 6, 7, and 8. It is noted that Seilhamer et al indicate that porcine probes did not bind to human cDNA library but it is disclosed that other "NP" probes can be used. The instant claims (30-32) indicate that the probe comprise a part of the porcine peptide and it is clear from Figure 8 of Seilhamer et al, and the disclosure of Seilhamer et al that probes such as full length probes of different species would comprise at least a part of the porcine sequence based on the homology disclosed in Figure 8, for example.

The amendment filed 2/7/94 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Claims 27 and 34 were

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added and each recites the use of a nucleic acid that encodes a specific 26 amino acid peptide (78nt) and claims 29 and 35 recite the use of a specific 108nt probe. These sequences are required by claims 26 and 33 to be nucleic acids produced via the cleavage of a nucleic acid encoding porcine natriuretic peptide with endonucleases XhoI and RsaI. It is disclosed in the specification at page 5, that the XhoI RsaI cleavage product is a 120nt fragment. The instant specification does not, therefore disclose the use of the specific probes recited in the subject claims.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claims 27, 29, 34 and 35 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See objection above.

Claim 33 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean R McGarry whose telephone number is (703)305-7028. The examiner can normally be reached on M-Th (6:00-4:30).

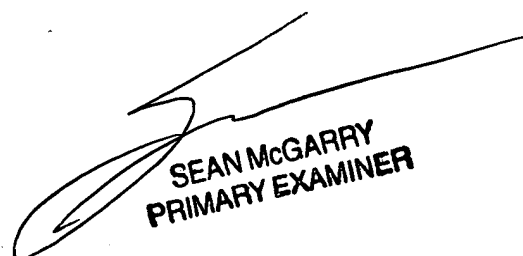
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader can be reached on (703) 308-0447. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

SRM
January 29, 2003



SEAN MCGARRY
PRIMARY EXAMINER